

## **REMARKS**

Claims 6-18 were pending in the application. Claims 6 and 11 have been amended and new claims 19-23 have been added. No new matter has been introduced. Support for the amendments can be found in Applicant's specification as published in United States Patent Publication 2002/0165901, specifically at paragraphs [0023] - [0029]. Applicant respectfully requests reconsideration.

## **CLAIM REJECTIONS UNDER 35 USC §101**

The Office Action rejected claims 6-10 under 35 USC §101 as being directed to non-statutory subject matter. The Examiner's argument centers on the test for being statutory by producing "a useful, concrete and tangible result" as indicated in *State St. Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998). In the case of *In re Bilski*, Case 2007-1130, page 20, (Fed. Cir, Oct 30, 2008), the Federal Circuit held that the arguments of *State Street* will no longer be considered dispositive of the issue of subject matter patentability. However, the Final Office Action maintains the rejection under 35 U.S.C. §101 on the basis that the claimed invention allegedly has no practical application. In an Advisory Action the Examiner admitted that the claims were tied to a machine (computer), but based on a memorandum dated May 15, 2008 (before the date of the *Bilski* decision) the test for compliance with 35 USC §101 still requires providing a real-world result. Although Applicant does not interpret *Bilski* as providing this test in order to advance prosecution, the claims have been amended to specifically provide a useful result – producing a new set of objects.

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Even though Applicant believes that the rejection under section 101 used the wrong test, to advance prosecution, claims 6 and 11 have been amended to require that the method produces a new set of objects.

For the foregoing reasons, Applicant respectfully requests allowance of the pending claims. The Director is hereby authorized to charge any fees which may be required, including any petition for extension of time fees under §1.17, or credit any overpayment, to Deposit Account Number 50-0510.

Respectfully submitted,

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